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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/684,942

10/14/2003

Jeff A. Krolik

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10/30/2006

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EXAMINER

HOUSTON, ELIZABETH

ART UNIT

PAPER NUMBER

3731

DATE MAILED: 10/30/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/684,942

Applicant(s)

KROLIK ET AL.

Examiner

Elizabeth Houston

Art Unit

3731

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 September 2006.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 31-67 is/are pending in the application.
- 4a) Of the above claim(s) 58-67 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 31-57 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14 October 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>112204, 121503</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Applicant's election without traverse of species A (Figures 4-11, claims 31-56) in the reply filed on 09/18/06 is acknowledged.
2. Originally numbered claims 57-66 (newly numbered claims 58-67) are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 09/18/06.

Specification

3. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: "the distal end of the retrieval adapter is *perforated*" as stated in claim 38 is not found in the specification.

Claim Objections

4. The numbering of claims is not in accordance with 37 CFR 1.126 which requires the original numbering of the claims to be preserved throughout the prosecution. When claims are canceled, the remaining claims must not be renumbered. When new claims are presented, they must be numbered consecutively beginning with the number next following the highest numbered claims previously presented (whether entered or not).

Misnumbered claims 39-66 have been renumbered 40-67.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

6. Claims 36, 40, 48 and 55 (original claims 36, 39, 47 and 54) are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

7. Claims 36, 48 and 54 recite the limitation "coupled to the distal end of the interventional device " in line 2. There is insufficient antecedent basis for this limitation in the claim. The independent claims do not positively recite "an interventional device". Rather, the claims merely require that the apparatus is capable of working in conjunction with an interventional device. Claims 36 and 47 recite that the retrieval adapter is coupled to the interventional device implying that the interventional device has been positively claimed. It is unclear whether applicant intends to claim the interventional device or not.

8. Claim 40 (original 39) recites the limitation "oblique opening", which is indefinite since there has been no point of reference given. Appropriate correction is required.

Claim Rejections - 35 USC § 102

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

10. Claims 31, 32, 35, 37, 39-44, 47, 49-52, 56 and 57 are rejected under 35

U.S.C. 102(e) as being anticipated by Daniel et al. (USPN 6,171,327).

11. Daniel discloses an apparatus capable of being used with an interventional device in retrieving a vascular filter. The retrieval adapter (18) has a proximal end, distal end and a lumen. The distal end includes a curved portion (Figs. 12 and 13) and one or more expandable slits (144, Fig. 10) configured to radially expand and receive at least a portion of the filter within the lumen. The proximal end of the adapter is tapered to facilitate engagement with an interventional device (Figs. 9-15). The adapter is made of biocompatible material. The interventional device is capable of being an angioplasty catheter or a stent delivery system.

Claim Rejections - 35 USC § 103

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. Claims 33, 34, 45, 46, 53 and 54 are rejected under 35 U.S.C. 103(a) as being unpatentable over Daniel in view of Ferrera (USPN 6,240,231).

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14. Daniel discloses the invention substantially as claimed as stated above except for the radiopaque coil.

15. Ferrera discloses using a radiopaque marker in the form of a coil.

16. It would have been obvious to one having ordinary skill in the art at the time of the invention to incorporate a radiopaque marker into the filter retrieval device to enhance the visibility of the device during use. It would have been obvious to one having ordinary skill in the art at the time of the invention to incorporate the radiopaque marker in the form of a coil since it provides the advantage of maintaining a low profile as well as maintaining flexibility.

17. Claims 36, 48 and 55 are rejected under 35 U.S.C. 103(a) as being unpatentable over Daniel in view of Green (USPN 6,485,501).

18. Daniel discloses the invention substantially as claimed as stated above except for the interventional device.

19. Green discloses a retrievable vascular filter system in combination with an interventional device such as an angioplasty catheter or a stent delivery system. The system is useful in preventing the risk of stroke, which can occur when emboli become lodged in the vasculature.

20. It would have been obvious to one having ordinary skill in the art at the time of the invention to incorporate an interventional device to enhance the use of the filter by allowing the physician to be able to deliver the components as one apparatus rather

than having to make multiple deliveries. The inventions are analogous with each other and the instant invention and therefore the combination is proper.

21. Claim 38 is rejected under 35 U.S.C. 103(a) as being unpatentable over Daniel.

22. Daniel discloses the invention substantially as claimed as stated above except for the perforations. The instant disclosure describes this parameter as merely preferable and does not describe it as contributing any unexpected result to the filter retrieval device. As such this parameter is deemed a matter of design choice (lacking in any criticality) and well within the skill of the ordinary artisan, obtained through routine experimentation in determining optimum results.

Double Patenting

23. Claims 31-34, 36-38, 42-45, 48 and 50-54 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-9, 11-19, and 21-25 of U.S. Patent No. 6,663,651 in view of Daniel (USPN 6,171,327).

The patent discloses all the features of the pending application including a retrieval adaptor with one or more expandable slits, radiopaque coil, and an interventional device. The patent does not disclose that the retrieval adaptor is radially expandable and has a curved portion. Daniel discloses that the retrieval adaptor is expandable and has a curved portion. It would have been obvious to one having ordinary skill in the art at the time of the invention to make the retrieval adaptor radially expandable since it is

an enhancement that would allow the adaptor to have a low profile when it is not engaging the filter.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Elizabeth Houston whose telephone number is 571-272-7134. The examiner can normally be reached on M-F 9:00-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anhtuan Nguyen can be reached on 571-272-4963. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

eh




ANH TUAN T. NGUYEN
SUPERVISORY PATENT EXAMINER

10/20/06